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Customer No. 30425

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Ren Egawa, et al.
Serial No. : 10/034,751
Filed : December 27, 2001
For : APPARATUS AND METHOD FOR TRANSCODING STILL IMAGE
DATA FILES INTO MPEG VIDEO DATA FILES AND DIGITAL
VIDEO PLAYER IMPLEMENTING SAME
Group No. : 2621
Examiner : Daniel T. Tekle

MAIL STOP APPEAL BRIEF-PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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The undersigned hereby certifies that the following documents:

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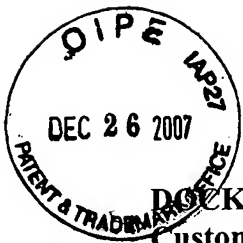
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DOCKET NO.: 01-MV-0111 (STMI01-01111)
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SAME
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MAIL STOP APPEAL BRIEF - PATENTS

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Sir:

REPLY BRIEF

The Appellants respectfully submit this reply brief in response to the Examiner's Answer
mailed October 19, 2007.



ARGUMENT

As previously noted, claim 1 requires, among other limitations, “a controller capable of dividing the digital still image file into a plurality of sub-picture files, the controller further capable of constructing an MPEG video stream from the plurality of sub-picture files” (emphasis added). *Werner*, cited as anticipating the claims, does not teach or suggest dividing a still image file into a plurality of sub-picture files. The Examiner’s Answer does not identify any teaching within *Werner* in which a still image file is divided into a plurality of sub-picture files, but instead merely argues that JPEG and MPEG data has sub-pictures (macroblocks) and that MPEG video data has a plurality of frames that the Examiner apparently believes might each be stored in separate files:

Werner teaches various compression standards include JPEG or MPEG decoder to divide digital still image in to plurality Macroblock or block and reconstruct to a picture or frame. There is no difference between constructing an MPEG video from the plurality of sub-picture and constructing an MPEG video from plurality of Macroblock since sub-picture made of plurality blocks. Also MPEG video is made of plurality image file or frames.

Examiner’s Answer, page 7. However, the mere existence of “sub-picture” (e.g., macroblock) data within the image data does not satisfy the limitation of a plurality of sub-picture files each containing a portion of a digital still image file. Moreover, a frame of video data does not constitute a “file,” and no specific teaching of either storing each individual frame in a separate file or storing each individual macroblock in a separate file is found in *Werner*. Accordingly, the rejection for anticipation is clearly unsupported by the record.

To the extent that the Examiner implies that it would be obvious to modify the teachings of *Werner* to achieve the claimed invention, such rejection should be made under § 103, not under §

102.

The Examiner's Answer, for the first time during prosecution of the subject application, states a proposed interpretation for the claim term "file" that purports to allow the claims to be contorted to read on *Werner*:

"File" can be broadly defined as "collecting items into a single unit so that processor can processes items as one unit. "Macroblock" of MPEG2 of Werner anticipates the claimed "file" because "Macroblock" is the collection of Y, Cb, and Cr blocks and is processed by the MPEG2 encoder as one unit.

Examiner's Answer, page 8. As an initial matter, the presentation of a proposed interpretation of claim terms for the first time on appeal is untimely, and should be treated as a new grounds of rejection warranting reopening of prosecution to allow the applicant to present evidence in opposition to the proposed interpretation or amend the claims. The basis or bases of a rejection must be clearly and specifically stated during prosecution, to afford the applicant an opportunity to meet the objection. See, e.g., *In re Oetiker*, 977 F.2d 1443, 1449 (Fed. Cir. 1992) (Plager, J., concurring) ("The Examiner cannot sit mum, leaving the applicant to shoot arrows into the dark hoping to somehow hit a secret objection harbored by the Examiner."). Accordingly, Appellants believe that prosecution should be re-opened in the subject application.

In addition, the unusual interpretation of "file" proffered in the Examiner's Answer differs from the ordinary meaning of that term. "File" is normally understood to mean a collection of data that is stored and transmitted as a single logical unit, separate from other files. The Examiner's Answer fails to provide or point to evidence supporting the unusual interpretation proffered therein, and therefore no evidence of record supports that interpretation of "file."

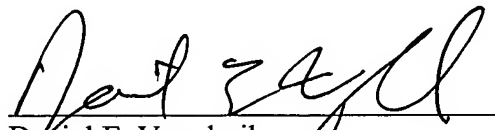
Regardless, the proposed interpretation of “file” still does not enable *Werner* to anticipate the claimed invention. The claims recite dividing digital still image data into a plurality of sub-picture files, then constructing an MPEG video stream from those sub-picture files. This requires transcoding of the digital still image format data into MPEG video data, either before or after the digital still image data is divided into sub-pictures. While the Examiner’s Answer cites to teachings in *Werner* of both still image (JPEG) data and MPEG video data, the Examiner’s Answer fails to identify where transcoding between such JPEG and MPEG data is taught in *Werner*. In fact, *Werner* fails to teach or suggest transcoding. Mere similarity between the formats of JPEG and MPEG data (e.g., both use macroblocks) does not make the data identical and/or interchangeable – in fact, it is not. Nor does the mere mention of an encoder capable of separately operating on JPEG and MPEG data constitute a teaching of transcoding data in one format into data in the other format. Accordingly, even with the newly-added and strained interpretation of “file” proffered in the Examiner’s Answer, *Werner* does not anticipate the claims.

Therefore, the Appellants respectfully request the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

Respectfully submitted,

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